

Application No. 09/822,693  
Amendment dated December 8, 2003  
Reply to Office Action of August 8, 2003

### **Remarks**

Claims 1 and 5-19 are pending in the present application. Claim 4 is cancelled by the present amendment, and claims 2 and 3 were previously cancelled. Claims 1 and 4-19 were rejected under 35 U.S.C. §103(a) as obvious over Colbow et al. U.S. Patent No. 6,472,090 in view of Kawatsu U.S. Patent No. 5,677,073.

### **Amendments to the Claims**

As noted in the August 8, 2003 Office Action, Applicants had submitted new claims that were numbered 4-18, and this was in error, since claim 4 had already been presented, but the Examiner renumbered the claims as claims 5-19. The following list incorporates the Examiner's renumbering. Applicants have also amended several claims to correct their dependencies in view of the renumbering.

### **Objection to Claim 19 Under 37 C.F.R. §1.75(c)**

The Office Action objected to claim 19 37 C.F.R. §1.75(c) as being of improper dependent form for failing to further limit the subject matter of a previous claim. Claim 19 recited the same subject matter as claim 18, from which claim 19 depended.

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Applicants have amended claim 19 so as to depend from claim 12. Accordingly, the objection has become moot and may properly be withdrawn.

**Rejection of Claim 4 Under 35 U.S.C. §112, Second Paragraph**

Claim 4 was rejected under 35 U.S.C. §112, second paragraph, as being indefinite. The Office Action stated that claim 4 depends from claim 2, which has been cancelled. Applicants have cancelled claim 4 without waiver or prejudice.

**Rejection Based on Obviousness-Type Double Patenting**

Claims 1 and 4-19 were rejected for obviousness-type double patenting in view of Colbow et al. U.S. Patent No. 6,472,090 in view of Kawatsu U.S. Patent No. 5,677,073. In order to expedite the allowance and issuance of the present application, Applicants are submitting a Terminal Disclaimer to overcome the obviousness-type double patenting rejection. Applicants' submission does not constitute an admission as to the accuracy or effect of the obviousness-type double patenting rejection.

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**Common Ownership Of The Present Application  
And U.S. Patent No. 6,472,090**

Applicants submit that the subject matter claimed in U.S. Patent No. 6,472,090 and the subject matter of the pending claims of the present application were commonly owned at the time those subject matters were made. All the inventors of U.S. Patent No. 6,472,090 and of the present application had an obligation to assign the relevant inventions to Ballard Power Systems Inc. the time those inventions were made.

Common ownership at the time the inventions were made is also evidence by the assignment of the present application and U.S. Patent No. 6,472,090 to Ballard Power Systems Inc.

The assignee of the present application is Ballard Power Systems Inc., a corporation organized and existing under the Canadian Business Corporations Act, and having a place of business at 9000 Glenlyon Parkway, Burnaby, British Columbia, Canada V5J 5J9. The assignment of the present application to Ballard Power Systems Inc. was recorded in the U.S. Patent and Trademark Office on July 23, 2001, at Reel 011999, Frame 0441.

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U.S. Patent No. 6,472,090, entitled "Method And Apparatus For Operating An Electrochemical Fuel Cell With Periodic Reactant Starvation", which issued on October 29, 2002, is also assigned to Ballard Power Systems Inc. The assignment from individual named inventors (Kevin Michael Colbow; Marian van der Geest; Cindy J. Longley; Jens Muller; Joy Roberts; Jean St-Pierre; Peter Urban; Regina Wezel; David P. Wilkinson; Jiujun Zhang) to Ballard Power Systems Inc. was recorded in the U.S. Patent and Trademark Office on April 29, 2002, at Reel 12851, Frame 0081.

Accordingly, U.S. Patent No. 6,472,090 is disqualified as 102(e)/103(a) prior art, pursuant to 35 U.S.C. §103(c). Applicants' disqualification of U.S. Patent No. 6,472,090 as prior art with respect to the present application does not constitute an admission regarding any statement in the Office Action regarding Colbow et al. U.S. Patent No. 6,472,090 or Kawatsu U.S. Patent No. 5,677,073.

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The Examiner is invited to telephone the applicants' undersigned attorney at (312) 775-8202 if any unresolved matters remain. Please charge any additional fees, and credit any

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overpayment, incurred in connection with this submission to  
Deposit Account No. 13-0017.

Respectfully submitted,



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